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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/947,668	10/09/1997	TRACEY C. SLEMKER	534128-002-C	6180

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EXAMINER	
WILLSE, DAVID H	

ART UNIT	PAPER NUMBER
3738	

DATE MAILED: 05/28/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	08/947,668	SLEMKER, TRACEY C.	
	Examiner	Art Unit	
	Dave Willse	3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 May 2003* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *43-83* is/are pending in the application.

4a) Of the above claim(s) *43 and 64-78* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *44-63 and 79-83* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

Claims 43 and 64-78 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 20.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the sleeve (e.g., claim 44, line 2) must be shown or the feature canceled from the claims. No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees (*In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969)).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application (37 CFR 1.130(b)).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 44-63 and 79-83 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of U.S. Patent No. 5,702,489. Although the conflicting claims are not identical, they are not patentably distinct from each other because the features are either set forth in the claims of the patent or would have been immediately obvious from said claims. For example, a silicone sleeve would have been directly obvious from its well known advantages pertaining to comfort, sealing, etc. and from the intent

of "providing forced transfer of gas to and from a prosthetic limb socket" (patent claim 6, first two lines).

Claims 44-49, 60, and 81-83 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 44, line 3, "the interior distal end" lacks a proper antecedent basis. In claim 45, line 2, "forces" should be replaced by --forced--. In claim 60, line 2, "the" is misspelled. In claim 81, lines 5-6, "said base" (as opposed to "said base-plate") lacks a proper antecedent basis. Other errors were noted.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 44, 45, 47, 49-53, and 56-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sandmark, SE 8801686 A, which discloses a base **7** attached (at least in part) to the interior distal end **2** of the socket and a duct **6, 11** connected to a channel in the base **7**. A sleeve to be worn over the residual limb would have been immediately obvious, if not inherent, in order to provide comfort to the amputee and to improve the sealing for donning and doffing of the artificial limb. A valve coupled to the duct **6, 11** would likewise have been obvious, if not

inherent, in order to provide a readily accessible means for shutting off the vacuum and/or pressure without having to reach the apparatus **5** itself. Regarding claims 47 and 53, it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform; it does not constitute a limitation in any patentable sense (*In re Hutchison*, 69 USPQ 138); element **7** is certainly *capable* of being removed from element **8**, whether or not such was the intent. Regarding claim 57, a check valve releasably coupled to the channel through base **7** would have been obvious in order to close off the opening and maintain the vacuum after donning.

Claims 50, 56, and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Catranis, US 2,530,285, which discloses a valve assembly (Figure 2) removably coupled to the distal end of the socket **1** but which apparently lacks a sleeve to be worn over the residual limb. Liners and socks, however, were well known in the art at the time of the present invention and would have been obvious in order to provide comfort to the amputee and to improve the seal with the socket **1**.

Claims 44, 45, 47, 48, 50-53, 55, and 83 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Surerus, DE 27 29 800 A1, which includes a sleeve (represented by the dotted, dashed line in Figure 3, or such a sleeve would have been inherent), a base or base-plate (just under the pneumatic ring **22**), a duct **24**, and a valve assembly **I** and **II**. Regarding claim 45 and others: Derwent abstract, last line.

Claims 49, 56-60, 62, and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Surerus, DE 27 29 800 A1. A sealing sleeve of silicon or the like along with the valve **II** being a check valve (with element **2** being the channel) would have been obvious, if not inherent

(Figure 1 certainly appears to depict a check valve), in order to provide a partial vacuum within the socket for affixing onto the residual limb of an amputee.

Claims 44, 46, 47, 49, 50, 52-54, 56, 57, 59-63, and 79-83 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Toles, US 980,457. The base **18** includes two channels **19'** connected to a central duct and a valve **15**. Regarding claim 46 and others, the upright assembly comprises elements **20**, **22**, and **24**. For claim 80, sack **12** and/or sheath **16** may alternatively be viewed as the annular projection claimed. Regarding claim 83, the "pump" (last line) is not a positively recited element; the various ports or openings in the Toles structure are certainly *capable* of being coupled with a pump, whether or not such was the intent.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Willse, whose telephone number is (703) 308-2903. The supervisor, Corrine McDermott, can be reached at (703) 308-2111. The receptionist's phone number is (703) 308-0858, and the main FAX numbers are (703) 305-3591, 3590.

dhw: D. Willse
May 21, 2003

DAVE WILLSE
PRIMARY EXAMINER
ART UNIT 3738